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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,392	10/29/2003	Robert Frigg	8932-819	6817
20582	7590	05/04/2005	EXAMINER	
<b>JONES DAY</b> 51 Louisiana Avenue, N.W. WASHINGTON, DC 20001-2113				STOKES, CANDICE CAPRI
		ART UNIT		PAPER NUMBER
				3732

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/695,392	FRIGG, ROBERT
	Examiner	Art Unit
	Candice C. Stokes	3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 March 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-63 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-63 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/29/05

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1) Claims 1-7,19,21,25-34,38,40,44-45, and 46-49 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4,13-14, and 25-27 of U.S. Patent No. 6,669,701. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1,3-7,44, and 46-49 of the application and claims 1-4,13-14, and 25-27 of the patent lies in the fact that the patent claims include many more elements and is thus much more specific. Thus the invention of

claims 1,3-7,44, and 46-49 is in effect a “species” of the “generic” invention of claims 1-4,13-14, and 25-27. It has been held that the “generic” invention is anticipated by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1,3-7,44, and 46-49 are anticipated by claims 1-4,13-14, and 25-27 of the patent, they are not patentably distinct from claims 1-4,13-14, and 25-27.

As to Claims 2 and 45, according to the limitations of Claim 1 it is obvious that the first center point is located between the second center point and the elongated outer periphery.

2) Claims 8-10,15-18,20,22,24,35-37,39,41,43,50-56,58-61, and 63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4,13-14, and 25-27 of U.S. Patent No. 6,669,701 in view of Johnston (USPN 3,716,050). The difference between the patent claims and the above-mentioned claims in the present application is that the present application requires that the elongated hole extends along or parallel to the longitudinal axis of the plate. In addition to the claimed limitations anticipated by the patent, Johnston discloses a “plate 20 consists of a first section 22 including a right angled extension or second section 24 at one end”. “The first section includes apertures 26, 28, 30 and 32 spaced longitudinally there along” and “aperture 34 in the second section 24. The apertures 26, 32, and 34 are of keyhole type and include slot extensions 26’ and 32’ extending in opposite directions along first section 22 and a slot extension 34’ extending along the second section 24 toward the free end thereof” (column 2, lines 18-29). FIG. 2 shows the plate 20 positioned in a manner “to place the proximal fragment 19 in tight compression with the distal ulna” and engaged by a spherical headed screw. Furthermore, “it will be noted that all of the apertures 26, 28, 30, 32 and 34 are provided with beveled counter-bores” or concave recesses (column 2, line

35). It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the elongated hole extending parallel to the longitudinal axis of the plate in order to provide rigid fixation to the fractured site without danger of breakage.

3) Claims 11-14,23,42, and 62 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4,13-14, and 25-27 of U.S. Patent No. 6,669,701 in view of Talos et al (USPN 5,709,686). Regarding Claims 11-14 the difference between the patent and these Claims lies in the fact that the present application discloses the plate having a plurality of holes. Furthermore Talos et al disclose, “the bone plate shown in FIG.1 comprises several holes 2. The holes 2 are designed to be so-called elongated slots and “the lower part of the hole 2 facing the bone application surface 4 is approximately circular in the direction transverse to the plate” (column 2, lines 36-38) and “the upper part of hole 2 away from bone contact surface 4 is oval” (column 2, lines 51-52). As shown in FIG.1 the elongated portion overlaps the circular portion. “An outside thread is in the circular segment of the hole 2 and, because of design constraints, runs only in the lateral part of the plate over an angular range of about 60° to 179°” (column 2, lines 40-44). Therefore it is inherent that the first angle at the upper surface and of the second angle at the bone-contacting surface are different. “FIG. 8 shows a bone plate fitted with a bone screw 7 comprising a spherical head 8, the plate, as indicated by the arrow 10, being able to generate compression. Regarding Claims 23,42, and 62 Talos et al teach in Fig. 5 the spherical head 8 of screw has a thread-head 9. It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the plurality of holes and threaded screw head as taught by Talos et al into the plate disclosed in

patent 6,669,701 in order to provide a plate more tightly securable to more areas of the bone for repair of fracture.

***Terminal Disclaimer***

The terminal disclaimer filed on 03/29/05 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of U.S. Patent No. 6,669,701 has been reviewed and is NOT accepted.

The person who signed the terminal disclaimer has failed to state his/her capacity to sign for the corporation or other business entity, and he/she has not been established as being authorized to act on behalf of the assignee.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candice C. Stokes whose telephone number is (571) 272-4714. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Candice C. Stokes

  
Cary E. O'Connor  
Primary Examiner